

REMARKS

Applicants thank the Examiner for indicating that the drawings filed on September 17, 2003 have been accepted by the Patent Office. In addition, Applicants thank the Examiner for acknowledging receipt of the certified copies of the priority documents pursuant to 35 U.S.C. § 119. Finally, Applicants thank the Examiner for considering the references listed in the Information Disclosure Statement submitted to the PTO on October 17, 2003. An earlier IDS was filed on December 26, 2000. Applicants respectfully request that the Examiner indicate consideration of the December 26, 2000 IDS in the next Office Action.

Claims 1-34 are all the claims pending in this application. Claims 24, 27 and 32 have been canceled. Claims 1, 5, 6, 9, 12, 16, 18, 20, 25, 28 and 33 are independent claims. Initially, Applicants have amended claims 1 and 5 to include a memory readable by the terminal device for storing information necessary to connect to the nearest access point. Further, claims 12, 16 and 18 have been amended to recite that a different color is provided for each communication device. Applicants have also amended claims 16 and 18 to reflect that a readable memory is “for” storing a communication address. Finally, claim 3 has been amended to reflect that the color of an individual user is applied to the communication device.

Claims 1-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tamiyuki (Publication No.: 07-327089), in view of Shigeki (Publication No.: 729694). In addition, claims 6, 16-21 and 23-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tamiyuki

in view of Vu (U.S. Patent No.: 6,557,104 B2). Claims 7 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tamiyuki, in view of Vu, and further in view of de la Huerga (U.S. Patent No.: 5,960,085).

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Tamiyuki, in view of Vu, and further in view of Billstrom (U.S. Patent No.: 5,729,537). Also, claim 22 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Tamiyuki, in view of Vu, and further in view of Koenck (U.S. Patent No.: 6,006,100). Further, claims 12-15 and 28-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tamiyuki, in view of Vu, and further in view of Aikawa (U.S. Patent No.: 5,884,047). Similarly, claim 30 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Tamiyuki, in view of Vu, and further in view of Aikawa, and further in view of Koenck.

(A) Claims 1-5 (103(a), Tamiyuki, in view of Shigeki)

Independent claims 1 and 5 address color coding the exposed part of a communications device according to “a kind of the communication device” (claim 1) or “for each communication device” (claim 5). The Examiner asserts that Tamiyuki addresses a communications device that can be inserted into and removed from a slot in a personal computer. On the other hand, the Examiner admits that Tamiyuki does not teach identifying a kind of communications device by the application of different colors. However, the Examiner asserts that Shigeki teaches applying a color code to differentiate between kinds of communications devices. (See paragraph 4 of

Office Action). Applicants respectfully traverse this rejection based on the amendments to claims 1 and 5, and to the following remarks.

Tamiyuki discloses a communication device which can be freely removed from and inserted into a slot of a terminal device. Shigeki discloses the technique of identifying a terminator based on an external color, when the terminator is inserted into a base, by coloring the case of the terminator according to type. However, even if the technique of removing and inserting a communication device into the slot of a terminal unit is disclosed by Tamiyuki, neither reference, either alone or in combination, discloses, teaches or suggests distinguishing a kind of communication device by color as recited in claims 1 and 5.

Using a plurality of insertable communication devices in a single terminal device was not known before the filing date of this patent application. Although the technique of classifying a terminator by color is disclosed in Shigeki, the technique of Shigeki is remarkably and sufficiently different from the combination of one of a plurality of communication devices and the terminal device of the present invention.

Further, as noted by the amendments to claims 1 and 5, the insertable communication device includes a memory readable by the terminal device in which the memory stores information necessary for the connection to a specific provider including a user name, a password and a telephone number of a nearest access point. This feature which is directly related to the “kind” of communication device is not disclosed in any manner in Tamiyuki and Shigeki.

Only the invention recited in claims 1 and 5 is capable of immediate connection to the nearest access provider when inserted into the slot of a terminal device.

(B) Claims 6, 16-21 and 23-27 (103(a), Tamiyuki, in view of Vu)

Turning to the § 103(a) rejection of claims 6, 16-21 and 23-27, and for the remainder of the claim rejections, the Examiner relies on the combination of Tamiyuki and Vu. This rejection covers independent claims 6, 16, 18, 20 and 25. These independent claims address authentication between an insertable communications device and a terminal device. At a minimum, these claims recite an insertable communications device which provides either a stored ID (claim 6) or a stored communication address (claims 16, 18, 20 and 25).

The Examiner asserts that Tamiyuki addresses a communications device that can be inserted into and removed from a slot in a personal computer. On the other hand, the Examiner admits that Tamiyuki does not teach authentication between a communications device and a terminal device. However, the Examiner asserts that Vu teaches a method of authentication which includes, among other steps, conducting collation between a terminal device and an inserted communications device by determining whether an ID stored in the communications device is the same as an ID registered at the terminal device. (See paragraph 21(b) of Office Action). Applicants respectfully disagree.

Vu is directed at a method and apparatus for secure processing of cryptographic keys stored on a token 74. (Col. 2, lines 53-64; Col. 3, lines 61-64) As such, Vu's token 74 does not contain a memory which stores any form of communication address or ID, as recited in claims 6,

16, 18, 20 and 25. In fact, token 74 “contains the cryptographic key and any other information which is needed by the cryptographic program.” (Col. 4, lines 28-31). Moreover, the “cryptographic key could be a cryptographic key in the symmetric key system or a private key as used in the Public Key Cryptography System.” (Col. 7, lines 32-35). However, there is absolutely no description of Vu’s token 74 also including the recited communication address or ID of the rejected claims.

Given the above, the Examiner’s asserted combination would not even produce Applicants’ claimed device. Further, it is clear that Vu does not provide the required motivation for the asserted combination. Accordingly, Applicants respectfully suggest that the Examiner’s position with respect to independent claims 6, 16, 18, 20 and 25 is without merit. Further, since claims 17, 19, 21, 23-24 and 26-27 depend from these independent claims, these dependent claims also remain allowable for the very same reasons.

(C) The Remaining § 103(a) Rejections which Require, at a Minimum, the Combination of Tamiyuki and Vu

As addressed above, Applicants respectfully submit that neither Tamiyuki nor Vu, either alone or in combination, provides the required disclosure, teaching, suggestion or motivation for the asserted combination. The remaining § 103(a) rejections all rely, at a minimum, on the asserted combination of Tamiyuki and Vu. Since this combination is improper, Applicants respectfully suggest that the remaining § 103(a) rejections are also without adequate support

because they depend, at a minimum, on this improper combination in addition to other references.

Applicants also submit that the Examiner is merely selecting individual elements from the various references. In order to gather the motivation to combine these unrelated elements to allegedly form applicants claimed apparatus, the Examiner is employing impermissible hindsight. Therefore, Applicants respectfully submit that the remaining § 103(a) rejections of claims 7-15, 22 and 28-34 are improper. Accordingly, pending claims 1-34 remain patentable.

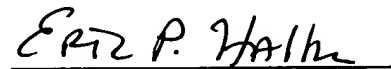
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Respectfully submitted,



Eric P. Halber
Registration No. 46,378

Date: October 25, 2004